

REMARKS

Following entry of the above amendment, claims 1-6, 8, 10, and 11 are pending. Claims 7 and 9 are cancelled. Claims 10 and 11 are withdrawn as being drawn to non-elected subject matter. Applicants amend claims 1 and 6 to focus on particular embodiments of the invention. Support for the amendment is found in the specification as originally filed. See, for example, page 7, fourth full paragraph; and page 9, fourth full paragraph, last sentence.

The Office Action states that claims 1-5 and 7-8 are rejected under 35 USC §102(a) as being anticipated by Smallheer *et al.* (U.S. Pat. No. 7,157,470 (Pat '470)). Applicants respectfully traverse the rejection. Applicants respectfully note that claim 7 is not a pending claim. Applicants further note that Smallheer *et al.* published January 8, 2004. The effective filing date of the instant application is June 19, 2003. Thus, Applicants assume that the Examiner meant to reject claims 1-5 and 8 under 35 USC §102(e) rather than claims 1-5 and 7-8 under §102(a), and Applicants respond accordingly.

The Office Action states that the compounds of the '470 patent, specifically those in Column 52, lines 20-25, and Column 52, lines 60-65, read on the instant claim, thus anticipate the instant invention. Applicants respectfully disagree. As stated in MPEP §2131 in pertinent part, "to anticipate a claim, the reference must teach every element of the claim." Both compounds of the '470 patent cited in the Office Action contain a piperidinone moiety. Such moiety corresponds to the substituent "Y" in the instant application. The Office Action correctly paraphrases that "Y is NRaRb, RaRb is together with N a heterocyclic ring." However, the Office Action fails to note that the resulting heterocyclic ring as claimed may be optionally substituted only with -C₁₋₄alkyl. The compounds cited in the Office Action from the '470 patent contain the heterocyclic ring "piperidinyl" substituted with "oxo" to form a piperidinone moiety. The definition of substituent "Y" of the instant application does not include a piperidinone moiety. Since the '470 patent does not teach each and every element of the claim, the '470 patent does not anticipate the instant invention. However, to further prosecution, Applicants amend claim 1. In light of the amendment and foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejection.

The Office Action states that claims 1-3 and 5-8 are rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement, because the “derivative” of the compounds of claim 1 are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term. Applicants respectfully traverse the rejection. Applicants respectfully note that claim 7 is not a pending claim. Applicants also note that claims 1 and 6 contain the term “derivative” and claims 2-5 and 8 depend from claim 1. Thus, Applicants assume that the Examiner meant to reject claims 1-6 and 8, and Applicants respond accordingly. As stated in MPEP §2163(I), to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. Also, MPEP §2163(I)(A) states that there is a strong presumption that adequate written description of the claimed invention is present when the application is filed. Further, MPEP§2163.04(I) states that a rejection for lack of written description must be supported with specific findings of fact, including (A) the claim limitation at issue and (B) reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed. Applicants submit that the claim language “derivative” has adequate written description as demonstrated by its inclusion in the specification as originally filed. See, for example, the instances of the term on page 4, 6, 9, and in the claims as originally filed. Also, the Examiner has failed to make any findings of fact that support a conclusion that a person skilled in the art could not recognize that the inventor was in possession of the claimed invention at the time the application was filed. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection.

The Office Action states that claims 1-3 and 5-8 are rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, because the “derivative” of the compounds of claim 1 are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term. Applicants respectfully traverse the rejection. Applicants respectfully note that claim 7 is not a pending claim. Applicants also note that claims 1 and 6 contain the

term "derivative" and claims 2-5 and 8 depend from claim 1. Thus, Applicants assume that the Examiner meant to reject claims 1-6 and 8, and Applicants respond accordingly. Although Applicants disagree with the Examiner's conclusion that the term "derivative" is indefinite, in order to further prosecution, Applicants amend claim 1 and claim 6. Claims 2-5 and 8 depend from claim 1. In light of the amendment, Applicants respectfully request reconsideration and withdrawal of the rejection.

The Office Action states that Claim 7 is rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement, because the term "use in therapy" is not defined in the specification so as to know the disorders to be treated or used in therapy by this compound. Applicants respectfully traverse the rejection. Applicants note that Claim 7 is not pending, thus the rejection is improper. Applicants respectfully request withdrawal of the rejection.

Applicants believe the present claims are in condition for allowance and such action is respectfully requested. If the Examiner has any outstanding issues with regard to the present claims, she is encouraged to telephone the undersigned for expeditious handling.

Should any other fees be deemed necessary to effect the timely filing of this paper, the Commissioner is hereby authorized to charge such fees to Deposit Account No. 07-1392.

Respectfully submitted,



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